

## **REMARKS**

### **Status of Claims**

Claims 1 – 43 were previously cancelled. Claims 44 – 51, 56, 57, 59 -76, 79 – 82, 84 – 89, 91 – 104, 109 – 110, 112 – 117, 119 - 132 are currently pending, and stand rejected at the present time. Without prejudice to future claims of patentability, the following claims were withdrawn on December 17, 2007: 52- 55, 58, 77, 78, 83, 90, 105 – 108, 111 and 118.

Of the pending claims, Claims 44, 99 and 124 are independent claims. Claims 45 – 98 depend upon Claim 44, claims 100 - 123 depend upon Claim 99, and claims 125 – 132 depend upon Claim 124.

In this Response, Claims 44, 96, 99 and 124 are amended, and find support throughout the Specification and drawings. Thus, for example, the claim amendments to Claim 44 find support at Specification, ¶¶ 0012, 0016, 0020, 0060, 0066, 0075, 00107, 00113 and the drawings. Similarly, for example, the claim amendments to Claim 99 find support at Specification ¶¶ 0016, 0075, 0077, 00109, 00113, 00122, 00129 and the drawings. Similarly, for example, the claim amendments to Claim 124 find support at Specification ¶¶ 0012, 0016, 0020, 0060, 0066, 0075, 0077, 00107, 00109, 00113, 00122, 00129 and the drawings.

Claims 50, 75, 103 and 128 are amended, and find support in the Specification, ¶ 0088.

New claims 133 – 134 are added, and find support in the Specification, ¶ 00120.

New claims 135 – 136 are added, and find support in the Specification, ¶ 00114.

### **Rejections Pursuant to 35 U.S.C. § 112**

The Office maintains several of its original rejections, namely, of claims 44 – 49, 51, 56, 59 – 63, 66 – 76, 80 – 81, 84 – 88, 91 - 104, 109, 112 – 116 and 119 - 132 pursuant to 35 U.S.C. 112.

Initially, it is noted that the Office has never previously asserted Section 112 claim rejections against claim 125 – 132, (as claims 124 – 132 were added through the Applicant's Response to April 9, 2008 Office Action). As such, the Applicant was never provided any opportunity to respond to this rejection. To prevent the Applicant any chance of responding to this rejection of the new claims is grounds for removing the current Office Action as being "final."

With regard to claim 44, it has been amended.

Next, the Office states that "The cited claims are replete with unclear language. Some examples include:" (12/9/08 OA, p. 2), but fails to identify every "example", which makes it impossible for the Applicant to address every "example". As asserted previously, if a Section 112 rejection is asserted, it is incumbent upon the Office to specifically identify whether the rejection is based on indefiniteness or on the failure to claim what applicants regard as their invention. See MPEP § 2171. Through its prior response, the Applicant attempted to review the claims for any

language which may need additional clarification, and the Office (in the current Office Action) acknowledged the Applicant's efforts. However, the Office continues to assert that claims 49 and 97 are required to be a Markush grouping of claims. Claims 49 and 97 are amended herein.

With regard to claim 128, it has been amended.

In light of the foregoing, reconsideration of the Office's Section 112 positions is respectively requested.

### **Rejections Pursuant to 35 U.S.C. § 103**

#### *a. The KSR Decision*

In the Applicant's prior Response (*see* Response to April 9, 2008 Office Action, filed August 8, 2008), the Applicant asserted that in order to determine obviousness, the Office should establish "some teaching, suggestion, or motivation to combine the [prior art] references" which is necessary when simple technologies are involved, because "[w]hen the art in question is relatively simple[,] the opportunity to judge by hindsight is particularly tempting." The Applicant advised that the tests of whether to combine references need to be applied rigorously, and as a consequence, the Applicant asserted that the Office has the burden of proof in asserting an obviousness rejection, and "particularly specify where the teaching, suggestion or motivation to combine references" occurs in the cited prior art so that "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." (*citations omitted*). The Applicant further asserted that the Office's identification "must be clear and particular, and it must be supported by actual evidence", and that a mere conclusory statement that the one of skill in the art would have the knowledge to combine references "does not in and of itself make it so, absent clear and convincing evidence of such knowledge." (*citations omitted*); *see also* MPEP § 2143.01 (a conclusory statement that a prior art reference would have be "well within the ordinary skill of the art" is not sufficient to establish obviousness); MPEP § 2144.03 (the Office must "point to some concrete evidence in the record to support" a finding of obviousness, so that "an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support.").

In the December 9, 2008 Office Action, the Office ignored the arguments found in the Applicant's prior response, citing the U.S. Supreme Court's decision in *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 127 S.Ct. 1727, 167 L.Ed.2d 705 (2007). As basis for the rejection, the Office asserted that the *KSR* decision "forecloses the argument that a specific teaching, suggestion or motivation is required to support a finding of obviousness." Office Action, p. 7 (*citation omitted*). As analyzed below, this statement from the Office regarding the *KSR* decision is legally incorrect, and as such, highly prejudices the Applicant's ability to respond to the pending claim rejections.

Despite the Office's assertion, the Court of Appeals for the Federal Circuit has held that the *KSR* decision did not lead to a dramatic or significant change of how obviousness is determined. *See*

*Cordis Corp. v. Medtronic Ave, Inc.*, 511 F.3d 1157, 1172 (Fed. Cir. 2008). Rather, the Federal Circuit has held that the teaching, suggestion, motivation (“TSM”) test continues to be readily available, but should not be “rigidly” applied. *See Black & Decker, Inc. v. Robert Bosch Tool Corp.*, 260 Fed. Appx. 284, 290 (Fed. Cir. 2008) (“This court has already said that the teaching, suggestion, motivation test remains good law for obviousness [even after the *KSR* decision], only a rigid application of that test is problematic.”) (*emphasis added*). As stated by the Federal Circuit:

The Supreme Court observed that this court had also elaborated a broader conception of the TSM test than was applied in [*KSR*]. Specifically the Court referred to *DyStar Textilfarben GmbH & Co. v. C.H. Patrick Co.*, wherein this court noted: “Our suggestion test is in actuality quite flexible and not only permits, but requires, consideration of common knowledge and common sense.” The Court suggested that this formulation would be more consistent with the Supreme Court's restatement of the TSM test. In any event, as the Supreme Court suggests, a flexible approach to the TSM test prevents hindsight and focuses on evidence before the time of invention, without unduly constraining the breadth of knowledge available to one of ordinary skill in the art during the obviousness analysis.

*See In re Translogic Technology, Inc.*, 504 F.3d 1249, 1260 (Fed. Cir. 2007) (*quotations and citations omitted*); *see also Anderson Corp. v. Pella Corp.*, 2008 WL 4927431 (Fed. Cir. 2008) (“we may still consider evidence of teachings to combine (and, presumably, not to combine) [using the TSM test] because, according to the Supreme Court, they capture a helpful insight’ into the obviousness inquiry.”) (*citation and quotation omitted*).

Moreover, in *Graham v. John Deere Co.*, 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966), the Supreme Court recognized that the obviousness inquiry is used to “guard against slipping into use of hindsight and to resist the temptation to read into the prior art the teachings of the invention in issue.” *Id.* at 36, 86 S.Ct. 684. Consequently,:

“a flexible TSM test remains the primary guarantor against a non-statutory hindsight analysis such as occurred in this case. The TSM test, flexibly applied, merely assures that the obviousness test proceeds on the basis of evidence - teachings, suggestions (a tellingly broad term), or motivations (an equally broad term) - that arise before the time of invention as the statute requires.

*Ortho-McNeil Pharmaceutical, Inc. v. Mylan Laboratories, Inc.*, 520 F.3d 1358, 1364 - 1365 (Fed. Cir. 2008) (*citation omitted*) (*emphasis added*); *see also Innogenetics N.V. v. Abbott Laboratories*, 512 F.3d 1363 n.3 (Fed. Cir. 2008) (even in light of the *KSR* decision, “We must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without any explanation as to how or why the references would be combined to produce the claimed invention.”).

Even after the *KSR* decision, evidence to support an obviousness rejection must be made explicit by the Office. *See e.g., In re Tzipori*, 2008 WL 4573007 (Fed. Cir. 2008) (“To facilitate review,

this [obviousness] analysis should be made explicit.”); *see also KSR*, 127 S.Ct. at 1741 (“[T]here must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”); MPEP § 2142.

Against this legal backdrop, both the U.S. Supreme Court and the Federal Circuit has made it very clear that the application of the TSM test is still a valid, useful and primary test to be employed when examining the issue of obviousness. Indeed, the edict from the Federal Circuit is that the TSM test is the “primary” test which must be used when allegations of hindsight reasoning is asserted (as is the case here). And, against this backdrop, the Office has an affirmative obligation to identify evidence from within the cited prior art to support a conclusion of obviousness, which it has failed to do in this case. Indeed, the Office fails to identify any portion of the cited prior art (by column, or drawing figure) to support its obviousness rejections.

Here, the Office did not give the Applicant’s prior response regarding application of the TSM test any merit, and instead, the Office merely concluded that the *KSR* decision allowed the office to ignore the Applicant’s prior response, which, as identified above, is legally impermissible.

The Applicant respectfully requests the Office to withdraw its Office Action as being “final” on this ground alone, and follow the Federal Circuit’s requirement of applying the TSM test, and identify to the Applicant where specifically in the cited prior art that some teaching, suggestion or motivation exists to make the combination to obviate the present invention. MPEP § 2144.03 (if the Office’s determination of obviousness is traversed, “the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained.”); *see also In re Sullivan*, 498 F.3d 1345, 1352 (Fed. Cir. 2007) (legal error exists when the Office fails to consider applicant’s arguments).

*b. Deficiencies of the Kipp Patent In Relation to the Present Claims*

The Office continues to maintain its Section 103 claim rejections over U.S. Patent No. 5,890,136 to Kipp (the “Kipp patent”) in view of U.S. Patent No. 5,158,155 to Domain et al. (the “Domain patent”).

The Applicant hereby incorporates by reference its Response filed August 8, 2008.

It is clear that the Kipp patent expressly teaches a low-volume, two-lane drive-up structural configuration which lacks the flexibility of high traffic throughput needed for high volume purchases by customers or the associated high traffic which occurs during peak sales periods. *See e.g.*, Kipp patent, Figures 5, 6, element 14; *see also* Exhibit A, ¶¶ 3 - 14; *see also* Exhibit B, ¶¶ 6 - 7. And, the Kipp patent fails to teach, either expressly or inherently,:

- a process having a computer system which is adapted to transport pre-ordered goods or serviceable items to an order assembly area for secure delivery to a customer as recited, for example, in Claim 1;
- a process having a structural facility having a centralized order processing portion adapted to hold time-sensitive goods or services separately and a plurality of at least

three access-controllable vehicle drive-thru pick up areas attached to the centralized processing portion adapted to receive a customer's vehicle as recited, for example, in Claim 44;

- a process having a computer system which is adapted to transport pre-ordered goods or serviceable items to a staging area for secure delivery to a customer as recited, for example, in Claim 44;
- a process having a computer system which is adapted to communicate with at least one electronic device controlled by the customer to automatically identify the customer's location and deliver approved ordered goods or services to the customer's location as recited, for example, in Claim 44;
- a process having the core computer selectively allowing the customer to communicate with one or more good or service providers through an audio/video network over the ordering device, as recited, for example, in Claim 99;
- a process having the core computer directing a customer to an access controllable order station, as recited, for example, in Claim 99;
- a process having the core computer selectively obtaining and storing perishable goods, non-perishable goods, and serviceable items in predefined areas, as recited, for example, in Claim 99;
- a process having the core computer selectively controlling the predefined areas to deliver the perishable goods, non-perishable goods, and serviceable items to the customer at a delivery station, as recited, for example, in Claim 99;
- a process having the core computer maximizing the customer's order throughput by directing the assembly of the customer's order, as recited, for example, in Claim 124; and
- a process having the core computer being adapted to optimize vehicle traffic flow through the order station and the delivery station, as recited, for example, in Claim 124.

Additionally, the Kipp patent fails to teach or suggest, either expressly or inherently, several distinctions found in the pending dependant claims, including:

- a process having a plurality of staging lanes, wherein each staging lane is in communication with the core computer system to control traffic, as recited, for example, in Claim 45.
- a process having a vehicle drive-thru pick up area having at least one order placement and delivery station, where the order placement and delivery station is adapted to receive, process and deliver at least one order from a customer, as recited, for example, in Claim 46.

- a process having an order placement and delivery station adapted to receive service items from a customer, as recited, for example, in Claim 47.
- a process having a pre-ordering communication means further adapted to provide pre-sale information to the customer, pricing, including time-sensitive coupon specials, discounts, close-outs and related pre-sales information, corresponding to the classified goods and serviceable items, as recited, for example, in Claim 50.
- a process having a verification system comprising a biometric verification system, the biometric verification system, as recited, for example, in Claim 57.
- a process having a facility comprising a pre-defined area for receiving customer exchanged goods, for receiving damaged goods, for receiving mis-processed goods, for processing special handle goods and for providing refunds if necessary, the pre-defined area being in communication with the core computer system through a materials handling system, as recited, for example, in Claim 59.
- a process having a pre-defined area for customer service, the pre-defined area being in communication with the core computer system through a materials handling system, as recited, for example, in Claim 60.
- a process having a pre-defined area for customer assistance, the pre-defined area being in communication with the core computer system through a materials handling system, as recited, for example, in Claim 61.
- a process having a pre-defined food pick up area within the drive-thru pick up area, the prepared food pick up area adapted to deliver food pre-ordered by a customer, as recited, for example, in Claim 62.
- a process having at least one pre-defined area for receiving, storing and transporting goods and services which require predefined environmental controls, as recited, for example, in Claim 63.
- a process having a core computer system which is adapted to monitor or otherwise sense emissions from a vehicle within or adjacent to the facility, and control one or more exhaust control systems in the facility to vent away the emissions from the facility, as recited, for example, in Claim 65.
- a process having a structural facility which is adapted to annex to, or otherwise structurally couple to, an existing structure, as recited, for example, in Claims 66 - 70 and 91 - 95.
- a process having a vehicle drive-thru pick up area and which further comprises at least one order placement station and at least one delivery station therein, the order placement

station and the order delivery station adapted to receive, process and deliver at least one order from a customer, as recited, for example, in Claim 71.

- a process having an order placement and delivery station further adapted to receive service items from a customer, as recited, for example, in Claim 72.
- a process having a pre-ordering communication means comprising a computer device, the computer device adapted to receive and store customer information, customer preferred product information, and past customer order information, and is further adapted to track discarded goods, track inventory for replenishment, generate future order information, and upon command by the customer, replenish goods by communicating at least one order to the core computer system for subsequent delivery to the customer, as recited, for example, in Claim 79.
- a process having a verification system which is in communication with the core computer system, the verification system adapted to authenticate identification of the customer who is purchasing the ordered good or service, verify the customer's ability to purchase the ordered good or service, and if authentication and identification is confirmed, communicate to the core computer system to deliver the ordered good or service to the customer, as recited, for example, in Claim 81.

The foregoing recitations are found variously throughout the other dependant claims (*e.g.*, pending claims 99 – 123). In the December 9, 2008 Office Action, the Office either generally states that these recitations are included in the Kipp patent (without identifying any citation to where such teachings exist in the Kipp patent), or, completely fails to respond to any of these important distinctions over the prior art based on the *KSR* decision. And, the Office completely fails to cite or rely on any other prior art (either separately or in combination with the Kipp patent) in rejecting these dependant claims under Section 103.

Moreover, the Office asserts “Regarding Claims 59, 60, 61, 102, 112, 113, 114, official notice is taken that it would have been obvious to incorporate an area to handle special goods, provide refunds, receive returns or handle customer queries/customer service, as typical retail establishments are well-known to have such areas.”. *See* 12/9/08 OA, p. 5, ¶ 24. However, this analysis supports the Applicant's assertion that the Office is engaging in improper hindsight reasoning, and is using the present application as a roadmap in order to apply the prior art as obviating references to the present invention. As identified previously, Section 103 requires the Office to consider the claimed invention “as a whole”. As a consequence, the Office is required to take each of the cited claims in which official notice is asserted, and view them as a “whole”, so that, for example, Claim 59 is dependant upon Claim 46, and Claim 46 recites a vehicle drive-thru pick up area comprises a plurality of staging lanes to accommodate a plurality of customer vehicles, each staging lane being in communication with the core computer system to control traffic. The Office did not (and could not) take “official notice” of the recitation of Claim 46, that through dependency, is also included in Claim 59. Claim 46, in turn, is dependant upon Claim 44, which recites a process for controlling a vehicle drive-thru or drive-up facility having several inventive process steps. The Office did not (and could not) take “official notice” of the recitation of Claim 44, that through dependency, is also included in Claim 46 and Claim

59. What the Office has done here, by taking “official notice” of recitations set forth in dependant claims, is to separate the inventive steps in these claims without examining the invention as a whole and examining these claims based upon their dependency. This is impermissible. See MPEP § 2144.03 (“Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, the notice of facts beyond the record which may be taken by the examiner must be ‘capable of such instant and unquestionable demonstration as to defy dispute.’”). Because the Office failed to take the inventions recited in Claims 59, 60, 61, 102, 112, 113 and 114 as a whole as required under Section 103, the Office’s “official notice” must be withdrawn.

The Applicant submits that until the Office responds to these important distinctions, an obviousness rejection cannot be properly maintained.

c. *The Kipp Patent Combined with the Domain Patent*

Pursuant to 35 U.S.C. 103, the Office must consider the claimed invention “as a whole”. The Federal Circuit has explained that one of the reasons this requirement exists is to prevent the use of hindsight reasoning. See *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270 (Fed. Cir. 2004) (without considering the claimed invention as a whole, “using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result – often the very definition of invention.”). As a result, “The references themselves must provide some teaching whereby the applicant’s combination would have been obvious.” *In re Gorman*, 933 F.2d 982 (Fed. Cir. 1991). If not, the “absence of a suggestion to combine is telling in an obviousness determination.” *Litton Systems, Inc. v. Honeywell, Inc.*, 87 F.3d 1559 (Fed. Cir. 1996).

In the December 9, 2008 Office Action, the Office asserted that a proper motivation existed to combine the Kipp patent facility with the Domain patent’s use of traffic control for drive-in establishments, asserting “*it would have been logical* for one ordinarily skilled to have used Domain’s teaching since Kipp’s system would also be expected to exhibit volumes of traffic which if optimized would contribute to better efficiency and throughput of Kipp’s system.” Unfortunately, the Office fails to identify, anywhere, in either the Kipp patent or the Domain patent, this alleged *logic* exists. Indeed, it is incumbent upon the Office to identify where this motivation exists in either the Kipp patent or the Domain patent. See *Smith’s Ind. Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1337, 1356 (Fed. Cir. 1999) (when the motivation to combine is asserted to come from common sense knowledge or logic, “That knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge.”); see also *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004) (“the examiner ... must show some suggestion or motivation ... to make the new combination.”).

Additionally, as identified above, the Kipp patent fails as an obviating reference under Section 103 to all of the pending claims. The Office continues to apply the Domain patent to “fill the



gap” not found in the Kipp patent, namely, a computer which is adapted to optimize traffic flow through the drive-thru pick up area.

As recited previously, it is legally impermissible “simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the applicant's combination would have been obvious.” *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991); *see also Al-Site Corp. v. VSI Intern., Inc.*, 174 F.3d 1308 (Fed. Cir. 1999) (“To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.”) (*citation omitted*). This is true even after the *KSR* decision.

Importantly, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Again, this is true even after the *KSR* decision.

Here, without citation to the art of record or any evidence, the Office asserts a general conclusion that “it would have been logical for one ordinarily skilled to have used Domain’s teaching since Kipp’s system would also be expected to exhibit volumes of traffic which if optimized would contribute to better efficiency and throughput of Kipp’s system.” *See* 12/9/08 OA, p. 8, ¶ 32. Again, there are several problems with this analysis. For example, the Kipp patent fails as an obviating reference to the present invention, so that the combination of the Kipp patent with the Domain patent must also fail as obviating references. *See In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994) (references that teach away cannot serve as evidence of obviousness). Next, the Office again fails to identify any portion of either the Kipp patent or the Domain patent in which one of skill in the art would have the motivation to combine the two references to achieve the present invention. *See In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998) (“To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness[. This requirement] stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.”). Additionally, the Office’s general conclusion is legally impermissible, because the only way this combination might exist is if the Office used the present application as the blueprint to make this combination. *See In re Gorman*, 933 F.2d 982 (Fed. Cir. 1991) (“It is impermissible, however, simply to engage in hindsight reconstruction of the claimed invention, using the applicant’s structure as a template and selecting elements from references to fill the gaps.”). And, while the Office asserts that Kipp’s four separate computer systems is “a relative concept” because they can form “a collective whole or overall automated ordering system”, there is no mention of such a collective system in Kipp, and instead, the Kipp patent is replete with language of four, separate computer systems. In direct contrast, the present invention has shown the insight of applying a single core computer system that was contrary to the state of the art at the time this invention was filed. *See In re Larson*, 340 F.2d 965, 968 (C.C.P.A. 1065). Finally, even a named inventor of the Domain patent agrees that the Domain patent would not work with the Kipp patent in order to achieve the present invention, for numerous reasons. *See* Exhibit B, ¶ 8; *see also, e.g.,* MPEP § 2143.01 (“If the proposed

modification or combination of prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims prima facie obvious.”).

The Office has apparently taken the position that the *KSR* decision does not require the Office to identify where, in either the Kipp patent or the Domain patent, there is a teaching or suggestion to combine the two documents to achieve the present invention. As noted above, the Office still has the burden of specifically identifying this information to the Applicant when it makes an obviousness rejection, even after the *KSR* decision.

Here, the Office has failed to identify anywhere in the Kipp patent or the Domain patent where such a motivation exists. Because the Office has completely failed to specifically identify where this logic exists in the cited prior art (to thereby allow the Applicant to respond accordingly), an obviousness rejection cannot be maintained.

Because the Office fails to identify any teaching, suggestion or motivation in the Domain patent which would allow one of skill in the art to combine the Domain patent with the Kipp patent to achieve the present invention, this rejection for all pending claims must be withdrawn.

Reconsideration is respectfully requested.

*d. The Kipp Patent Combined with the Dickson Patent*

The Office continues to apply the Dickson patent to “fill the gap” of the present invention that the Kipp patent expressly fails to disclose, or namely, a structure having a pre-defined food pickup area as recited in Claims 62 – 64, 86 – 89, and 115 – 117. Again, the Office provides a general conclusion that because the Dickson patent discloses a food prep area, “it would have been apparent to one of ordinary skill in the art to offer food through Kipp’s ordering system since it would expand retail offerings thus resulting in increased sales and thus increased profits”. See 12/9/08 Office Action, p. 8.

Again, the Office’s position is not supported for numerous reasons. Because the Kipp patent fails as an obviating reference to the present invention as identified above, the combination of the Kipp patent with the Dickson patent must also fail as obviating references. Additionally, the Office fails to specifically identify where, in any portion of either the Kipp patent or the Dickson patent, there is some teaching, suggestion or motivation for one of skill in the art to have combined the two references to achieve the present invention. The only way the Office can combine the Kipp patent with the Dickson patent to “fill the gaps” is if the Office used the present application as the blueprint to make this combination, which results in hindsight reasoning, which is not permitted.

Reconsideration is respectfully requested.

*e. Secondary Consideration Evidence – Affidavit of Beltran*

While the Applicant believes that it has traversed any argument of obviousness, the Applicant will nevertheless submit further evidence of nonobviousness through secondary considerations, as permitted by *Graham v. Deere Co.*, 383 U.S. 1, 17 - 18, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966) (such evidence including, but not limited to: (1) scope and content of the prior art, (2) the differences between the prior art and claimed invention, and (3) the level of ordinary skill in the art.).

Attached to this Request is an Affidavit Pursuant to 37 C.F.R.1.132 executed by Cesar Beltran. See Exhibit A. Mr. Beltran testifies that he has significant experience in the retail grocery industry, and as such, testifies as one of skill in the art. *Id.*, ¶ 1. See *In re Saul Tzipori*, 2008 WL 4573007 (Fed. Cir. 2008) (citation omitted) (“The level of skill in the art is important to obviousness analysis because a more skilled artisan will have more general knowledge on which to rely in combining teachings from multiple references.”).

It is clear to Mr. Beltran, as an industry expert, that the grocery business, as the type of industry contemplated by the present invention, is based on high volumes and low margins of profit. *Id.*, ¶ 6. Accordingly, the Kipp patent fails as an obviating reference to the present invention because, as described by this industry expert, “Kipp cannot possibly accommodate high volume vehicle throughput for groceries since in the Kipp patent there is a two vehicle limit”, which cannot “accommodate the variations of low-volume traffic to high-volume traffic” that exists in the grocery business. *Id.* The ability to accommodate traffic control is one critical requirement in the high-volume grocery business, as this industry “must continually optimize and adjust to traffic flow and sales volume” so that Kipp’s disclosed facility cannot “handle and deliver the huge volume of goods and services and thousands of sales transactions per day”. *Id.* And, as stated by this industry expert, “High traffic, high volume, low-margin, low cost sales of nondurable goods and services provided to the public on a daily basis requires computer controlled access lanes and access-controllable vehicle drive-thru pick up areas” as disclosed and claimed in the present invention. *Id.*

Moreover, this industry expert testifies that the Kipp patent fails to appreciate the need for an on-site pre-ordering process for subsequent delivery of goods. *Id.*, ¶ 7. Mr. Beltran, as an industry expert, opines that “a person of skill in the grocery field would necessarily have wanted to include onsite ordering if it pertained to all grocery, prescription drugs, prepared foods, etc. and almost any perishable goods and impulse items” as disclosed and claimed in the present invention. *Id.*

Indeed, while the Kipp patent discloses off-site ordering of *goods*, the Kipp patent fails to have any suggestion, motivation or teaching of providing *services* to a consumer. *Id.*, ¶ 8. As opined by this industry expert, Kipp’s failure “eliminates the possibility of providing pharmaceutical items to the pickup station, eliminates any deli foods, perishables, prepared (hot or cold) goods, as well as eliminates any banking services and many other frequently needed services.” *Id.* According to the expert, the requirement for providing services in a novel facility “are a predominate and inseparable feature of almost all current convention drive-thru business models” so that Kipp’s failure to disclose or appreciate providing services to a consumer “*Id.* And, as clearly identified and claimed in the present invention, the present invention includes numerous references to onsite ordering, a disclosure which Kipp fails to provide or even

appreciate. As Mr. Beltran testifies, “a person of skill in the grocery field would necessarily have wanted to include onsite ordering if it pertained to all grocery, prescription drugs, prepared foods etc. and almost any perishable goods and impulse items.” *Id.* This industry expert concludes “services are an imperative addition to a one-stop drive-thru facility” so that Kipp’s failure to provide services to a consumer evidences nonobviousness. *Id.*

Additionally, Mr. Beltran opines that the Kipp patent fails to appreciate that the utility of having a holding area for pre-ordered goods in a controlled temperature environment. *Id.*, ¶ 9. Thus, as Mr. Beltran testifies, certain food items are perishable and require one or more temperature-controlled holding areas, which means that the Kipp patent is limited only to providing non-perishable goods. In this regard, Mr. Beltran testifies that it would be “impossible for anyone skilled [the art] not to reference the necessity of equipping [the Kipp facility] with a controlled temperature” system as disclosed and claimed in the present invention. *Id.*

Further, Mr. Beltran testifies that certain hot foods have time restrictions imposed by U.S. government regulations. *Id.*, ¶ 10. He also testifies that certain items require preparation, for later pick-up by the consumer. *Id.*, ¶ 11. In contrast to the disclosure and claims of the present invention, the Kipp patent fails to appreciate the use of controlled temperature holding areas. *Id.*, ¶ 10.

Mr. Beltran also testifies that certain restricted goods require secure distribution to a customer (e.g., pharmaceuticals, for example, as well as tobacco products or alcohol). *Id.*, ¶ 12. The Kipp patent, Mr. Beltran states, completely fails to expressly or inherently disclose the distribution of such goods in secure manner to the customer as is disclosed and claimed in the present invention. *Id.*

Mr. Beltran concludes his testimony concerning the Kipp patent by stating “I conclude that the ‘articles’ for automated distribution to a car cannot include most perishable grocery goods, cannot include any services, cannot include secure prescriptions and does not allow for a system that fulfills onsite orders. It is my opinion that the Kipp patent is clearly not intended to provide the type and variety of everyday consumables, nondurable goods and services typically sold by the grocery store industry” as described and claimed in the present invention. *Id.*, ¶ 14.

Thus, Mr. Beltran’s testimony provides independent evidence of secondary consideration showing that the Kipp patent does not obviate the present invention. *See Ortho-McNeil Pharm., Inc. v. Mylan Labs.*, 520 F.3d 1358, 1365 (Fed. Cir. 2008) (secondary consideration evidence “constitutes independent evidence of nonobviousness.”); *see also Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579 (Fed. Cir. 1997).

*f. Secondary Consideration Evidence – Praise by Others in the Industry*

The Oxford Institute of Retail Management is a branch of the prestigious Oxford Said Business School located in Oxford, United Kingdom. *See Exhibit B, ¶¶ 2 - 4* (Saigh Affidavit Pursuant to Rule 1.132). The Oxford Institute of Retail Management was established in 1985 and has worked for over 20 years to relate sound scholarship to the practical needs of retailers, service

companies and public sector agencies. The Institute's teaching and research is undertaken at national, European and global scales. *Id.*

In the Autumn of 2007, the Oxford Institute of Retail Management published a feature article in its European Retail Digest (Issue 55, attached to Exhibit B as Attachment 1) praising the benefits of the technology covered by the present application. The Retail Digest is the flagship publication of Oxford University, and has (since 1993) provided retail practitioners, analysts and academics with worldwide perspectives and authoritative insights into the global retail industry. See <http://www.sbs.ox.ac.uk/oxirm/The+Retail+Digest.htm>. The feature article in the Retail Digest was titled "New Formats from New Retailers: Breakthrough Concepts from the US". In this article, the Oxford Institute of Retail Management lauded the technology covered by the present application, stating, for example,:

- i) that the technology covered by the present invention is "venturing into new formats in greater numbers than ever, developing new footprints to serve the specific needs of specific customers by applying "fresh, new perspectives to established businesses, from banking to fashion, allowing them to market in new and interesting ways."
- ii) that the technology covered by the present invention is a "best-in-class" retailer who has developed "new models for self-service, experimented with new, customer-facing technologies, and leveraged the recreation aspects of shopping."
- iii) that "Convenience retailing will become a significant force in the future as small gets big, and conventional convenience store operators will need to adapt and take advantage of this growing trend. These radical new innovations to make the shopping trip truly convenient mean that [the technology of the present invention] is posed to change the way people think about buying groceries."
- iv) that "To stay competitive, retailers must find new ways of reaching and engaging their customers. Towards that end, a small band of forward-thinking, new retailers have created innovative stores that capture the imagination and the loyalty of their shoppers. [the technology of the present invention] reintroduce[s] simplicity and convenience into their shoppers' lives[.] By addressing the specific needs of their specific customers, these six companies set new standards in customer-relevant innovation." *Id.*

The Oxford article was unsolicited. *Id.*

The foregoing unsolicited praise by a respectable educational institution serves as a source of objective evidence of nonobviousness. As frequently stated by the Federal Circuit, this type of "evidence is not just a cumulative or confirmatory part of the obviousness calculus but constitutes independent evidence of nonobviousness." *Ortho-McNeil Pharmaceutical, Inc. v. Mylan Laboratories, Inc.*, 520 F.3d 1358, 1364 - 1365 (Fed. Cir. 2008) (*citations omitted*); see also *Catalina Lighting, Inc. v. Lamps Plus, Inc.*, 295 F.3d 1277, 1288 (Fed. Cir. 2002) ("Objective indicia may often be the most probative and cogent evidence of nonobviousness in

the record.”); *see also PharmaStem Therapeutics Inc. v. Viacell, Inc.*, 491 F.3d 1342; *Eli Lilly & Co. v. Zenith Goldline Pharms., Inc.*, 471 F.3d 1369.

In light of the foregoing analysis, the Kipp patent (either alone, or in combination with the Domain patent or the Dickson patent) necessarily fails to obviate the rejected independent claims (*i.e.*, Claims 44, 99 and 124), and those claims which depend on these claims (*i.e.*, pending claims 45 - 98, 100 - 123 and 126 - 132).

Reconsideration is respectfully requested.

### **Conclusion**

In light of the foregoing amendments and remarks, entry of the foregoing amendments is respectfully requested. The Applicant submits that the proposed amendments, along with the foregoing analysis, place the application in position for allowance.

The undersigned would welcome a phone call from the Office to expedite the resolution of this application. A return postcard is attached, which the Applicant requests the Office to stamp and mail to the Applicant. The Applicant further submits a check for \$104.00 covering the fees for an additional four (4) dependant claims.

Respectfully submitted,

Dated: February 6, 2009

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